

## **REMARKS**

In the pending Office Action, Examiner Clemente has rejected all of the pending claims over one or more references, and has made other objections to this application. Entry of the above-noted amendment(s) and reconsideration of this application in light of them and of the remarks below is respectfully requested.

### **The Objection to the Drawings Should be Withdrawn**

Examiner Clemente requested a change to the drawings insofar as the number 17, used on page 6 of the application, did not appear in the drawings. An amended Figure 3 is being submitted, which includes the missing number and adds a further reference number 10, which is also included in other drawings. No substantive change to Figure 3 has been made, and no new matter has been added.

### **The Rejection under Section 112 Should be Withdrawn**

The Office Action alleged that claim 2 was not proper for lack of antecedent basis for the term “faces.” This ground of rejection is not conceded. However, as part of the amendments to claim 1 discussed further below, claim 1 includes a recitation of a pleated filter element having front and rear faces. No new matter is being added.

### **The Substantive Rejections of the Claims Should be Withdrawn**

The Office Action alleged that each claim was either anticipated by the Michaelis reference (US 6,045,600) or was obvious over a combination of Michaelis with one or more of the Rosenberg reference (US 4,187,182), the Doherty reference (US 6,579,350), and the Bause

reference (US 6,726,751). In light of the present amendments and remarks, these rejections should be withdrawn and the claims allowed.

The Michaelis reference relates to the moulding of an encircling peripheral frame around a pleated filter medium. Such a frame is referenced as 4 in Fig 1 of Michaelis. The reference's invention actually relates to the manufacturing of a frame which incorporates a gasket seal 2. The mould employed in Michaelis is shown in detail in its Figure 2 and described at column 2, lines 36-47. It will be noted that the mould comprises an upper die 9 and (although not shown in Fig. 2) there will be a similar lower die 9, the upper and lower dies meeting at the parting plane 8 of the mould. It will be further noted that the dies 9 in addition to having cavities defining a mould for forming the frame 4 locate against the upper and lower surfaces of the filter element 1.

With regard to independent claim 1, while Michaelis may show a number of the features of amended claim 1, the reference does not show or suggest all features of the claim. In particular, that reference does not disclose a mould unit having tapering projections that bite into peripheral regions of the front and rear faces of the pleated filter element, as now required by claim 1. For at least this reason, claim 1 is not anticipated by Michaelis, and its rejection should be withdrawn. Further, the teachings of Michaelis indicate that the dies 9 remain apart from the filter, and in fact the gasket-seal 2 is taught to be spaced from the filter as well. In view of the configuration of mould unit shown in Figure 2 of Michaelis, there is no reason why the skilled person would seek to modify that mould unit to include tapering projections that bite into the peripheral regions of the front and rear faces of the filter element so as to cause a slight depression therein, as recited in claim 1.

Claims 4 and 7-9 depend from claim 1, and they are allowable on that basis and/or on their own merit. The Rosenberg, Doherty, and Bause references noted in the Office Action do

not include a mould unit having tapering projections that bite into the front and rear faces of a pleated filter element, as recited in claim 1. The combination of the Michaelis reference with any of the secondary references does not result in all of the features of claim 1.

#### Additional Issue

Applicant wishes to bring to the Examiner's attention that claims in related patents have been "challenged" in the British and European Patent Offices. In both cases, the "challenge" is based on the disclosure in French Patent Specification No. 2 140 536 (Norit) and the Michaelis reference. Both of these references were identified in a prior Information Disclosure Statement.

Applicant believes that neither of these challenges has merit, and has responded to them along the lines given below. However, in an abundance of caution Applicant is submitting a new Information Disclosure Statement, which includes arguments made by an opponent and a translation of the Norit reference, to ensure that its duty of disclosure is met. As noted, the Norit and Michaelis references are already of record in this case, and the arguments themselves are not prior art and are not believed to be meritorious.

The Norit reference shows a mould unit for producing a frame in its Figure 6 that incorporates pointed blades 19 (see also Figure 5), which form a slight depression in the faces of the filter element. However, the filter element disclosed in Norit is not a pleated filter element, but rather is comprised of agglomerated particles. Consequently amended claim 1 defines novel subject matter.

As to obviousness, claim 1 as amended relates to a completely different type of filter element from that disclosed in the Norit reference. The Norit specification discloses a filter element which is comprised of agglomerated particles. In this respect see the second paragraph

on page 1 of the translation of the French specification and also the paragraph at page 3, lines 15 to 20 of the translation (included with the accompanying IDS). Such filter elements are solid bodies and would be well understood by the skilled person to have different characteristics from the pleated filter media to which amended claim 1 of the present application refers.

Thus the closest prior art of record to amended claim 1 of the present application is Michaelis since it relates to the same type of filter element as claim 1, namely a pleated element. In view of the configuration of the mould unit shown in Figure 2 of Michaelis, there is no reason why the skilled person would seek to modify that unit with tapering projections that bite into the peripheral regions of the front and rear faces of the filter element so as to cause a slight depression therein, as recited in claim 1. This is particularly so since Michaelis is concerned with moulding a frame incorporating a peripheral gasket seal, and is not particularly concerned with adapting the mould unit in the region of the front and rear faces of the pleated element.

Therefore, assuming that Michaelis is the closest prior art, claim 1 defines non-obvious subject matter. If, however, the starting point for obviousness analysis is (incorrectly) the Norit reference, then there is no reason whatsoever simply to substitute a pleated filter media for the filter for the filter element comprised of agglomerated particles as described in Norit.

### Conclusion

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the Office Action in the most expedient fashion.

Applicant reserves the right to later contest positions taken by the examiner that are not specifically addressed herein.

Reconsideration and passage to allowance in view of the above remarks is respectfully requested. Should it be determined that any further issues are outstanding, Examiner Clemente is encouraged to telephone the undersigned.

Respectfully submitted,

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